

cereal products from corn, wheat, oat, barley and rice." Applicants elect corn flakes, with traverse.

The Action is based on the incorrect supposition that claim 9 is a generic claim. In fact, claim 9 recites individual species linked by a genus claim, claim 8. MPEP §809.03 (8th

Ed. August 2001, Feb 2003 revision) (all cites to the MPEP herein are to this revision) states that a genus claim that links species claims is a "linking claim." According to the MPEP, where there is a linking claim, a restriction may be imposed. But, the proper practice is require the applicant to elect an invention and to examine the linking claim with the invention elected. "[S]hould any linking claim be allowed, the restriction requirement must be withdrawn." MPEP § 809.

Moreover, the MPEP provides a form paragraph to be used in the case of linking claims. See, MPEP § 809.03 at page 800-50. That paragraph provides that the Applicant is entitled to consideration of a reasonable number of disclosed species in addition to the elected species provided (as here) that all the claims to each additional species are written in dependent form or otherwise include all the limitations of an allowed generic claim.

Applicants surmise that the Action may have failed to note that claim 8 is a linking claim because there was an error in the dependency of claim 9 which, prior to amendment herein, depended from itself. Applicants respectfully observe, however, that the restriction among the various species of cereals set forth in claim 9 must be withdrawn if linking claim 8 is found allowable.

Applicants respectfully observe that the species recited by claim 9 are in a Markush group. While the discussion above is sufficient to show that the species recited by claim 9 must be examined together, for the sake of good order, Applicants further point out that the species election requirement of claim 9 does not accord with the Office's procedures for the examination of Markush groups.

MPEP § 803.02 emphasizes that, since *In re Weber, Soder and Boksay*, 198 USPQ 328, 331 (C.C.P.A. 1978),¹ it has been improper for the Office to refuse to examine what

¹ The Federal Circuit expressly adopted the holdings of the CCPA as precedent of the Federal Circuit.

the applicants consider as their invention by restricting a Markush group unless the subject matter in a claim lacks unity of invention. The MPEP section further indicates that if the members of a Markush group are so closely related that a search and examination on the merits can be made without serious burden, however, the examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions. *Id.* In the present case, the claimed method of the invention can be used on

each of the flaked cereals recited in the claim, and the Action has not even alleged, let alone show, that the species lack unity of invention. The members of the Markush groups in this case are, in fact, so closely related that there cannot be a serious burden on the Examiner to consider them on the merits together. Moreover, the Action does not even allege, let alone show, that there would be a serious burden on the examiner to search all the members of the Markush group together. Accordingly, for this separate reason, restriction among the various species of cereal recited in the Markush group set forth in claim 9 is not permissible under the Office's own procedures. Reconsideration and withdrawal of the requirement is respectfully requested.

III. Rejection of Claims 1 and 9 Under Section 112

The Action rejects claims 1 and 9 under 35 U.S.C. §112, second paragraph as indefinite. With respect to claim 1, the Action observes there is a minor error in phrasing in the last line of the claim. With respect to claim 9, the Action observes that the claim depends from itself. Applicants appreciate the close attention paid to these claims and have corrected these minor concerns herein.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

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If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,


Laurence J. Hyman
Reg. No. 35,551

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834
Tel: 415-576-0200
Fax: 415-576-0300
LJH:ljh
SF 1474593 v1

MARKED UP VERSION SHOWING CORRECTIONS

1. (Amended) A method for improving a cereal product, said method comprising
 - (a) contacting said cereal product with substantially pure water or with steam, and
 - (b) drying said cereal product to its original water content,thereby improving [reducing] the cereal product.

9. (Amended) A method of claim [9] 8, wherein said flaked cereal is selected from the group consisting of a corn flake, a wheat flake, an oat flake, a barley flake, and a rice flake.